UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,141	09/18/2003	Mario H. Skiadopoulos	1173-1034PUS2	7197

33883 7590 03/19/2009
Birch, Stewart, Kolasch & Birch, LLP
P.O. Box 747
Falls Church, VA 22040-0747

EXAMINER	
BOESEN, AGNIESZKA	
ART UNIT	PAPER NUMBER
1648	
MAIL DATE	DELIVERY MODE
03/19/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/667,141	SKIADOPOULOS ET AL.	
	Examiner	Art Unit	
	AGNIESZKA BOESEN	1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-129,183,232,255 and 278* is/are pending in the application.

4a) Of the above claim(s) *1-65,68-72,77-124,126-129,183,232 and 255* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *66,73-76,125 and 278* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/21/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The Amendment filed March 30, 2007 in response to the Office Action of October 2, 2006 is acknowledged and has been entered.

Election/Restrictions

Applicant's arguments with regard to the restriction requirement have been fully considered but are not persuasive. Applicant's arguments are the same as those presented in the traversal to the restriction requirement in Remarks on July 10, 2006. The restriction requirement is deemed proper and is FINAL for the reasons of record. Claims 66, 73-76, 125 and 278 are under examination in this Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Rejection of claims 75 and 76 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement **is maintained.**

Applicant's arguments have been fully considered but fail to persuade. Applicant argues that the required deposit has been made prior to filing of this application in connection with a different commonly owned US Patent application; Applicant fails to provide a number of the said application. Applicant states that a copy of the receipt for deposit of the strain is attached and the required Declaration regarding availability will be filed in the supplemental response. In

response, the Examiner notes that the Applicant has failed to file the Declaration. Thus the present rejection is maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Rejection of claims 67, 73, 74, 75, 255, and 278 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy *et al.* (WO 98/53078, herein, "Murphy") **is maintained.**

Applicant's arguments have been fully considered but fail to persuade. Applicant argues that Murphy's HPIV2 does not have a polyhexameric genome and that the polyhexameric genome is not an inherent property o Murphy's HPIV2. Applicant argues that the fact that the HPIV2 has a polyhexameric genome was not established at the time when the present Application was filed and that the polyhexameric genome should not be considered an inherent property of HPIV2 virus. Applicant submits a reference by Kawano et al. and argues that Kawano et al. teach that HPIV2 virus having a genome length that is not an even multiple of six nucleotides could be isolated and could replicate efficiently in cultures cells and that HPIV2 does not appear to absolutely obey the 'rule of six'.

In response to Applicant's arguments the Examiner notes that contrary to Applicant's assertion, the fact that the HPIV2 has a polyhexameric genome was established at the time when the present Application was filed. This fact is evidenced by the Kawano's reference that

expressly discloses that that the total number of nucleotides in the HPIV2 genome is a multiple of six. Kawano further discloses that the efficient replication of the genome occurs only when the total nucleotide numbers obey the 'rule of six' (see page 106, left paragraph). Thus the fact that the HPIV2 has a polyhexameric genome has been known at the time of the present invention. The present claims recite that the HPIV2 of the present invention is self-replicating (see claim 67). Thus it is the Office's position that Murphy's HPIV2 genome is polyhexameric, because if it was not the HPIV2 genome would not be self-replicating as required by the present claims. Examiner acknowledges that Kawano teaches that HPIV2 does not absolutely obey the 'rule of six'. However because the fact that the HPIV2 has a polyhexameric genome has been known at the time of the present invention and because Kawano discloses that the efficient replication of the HPIV2 genome occurs only when the total nucleotide numbers obey the 'rule of six', and Murphy's HPIV2 genome does replicate, it is the position of the Office that a polyhexameric genome is an inherent property of Murphy's HPIV2.

The mere recitation of newly-discovered function or property, inherently possessed by things in the prior art, does not cause the claim drawn to those things to distinguish over the prior art (See *In re Best, Bolton, and Shaw* 195 USPQ 430 (CCPA 1977), *In re Schreiber* 44 USPQ2d 1429).

Thus in view of the foregoing the rejection is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Rejection of claim 76 under 35 U.S.C. 103(a) as being unpatentable over Murphy *et al.* (WO 98/53078, herein, "Murphy") as applied to claims 67, 73, 74, 75, 255, and 278 above and further in view of Skiadopoulos et al. (Journal of Virology, 1999), and in view of Skiadopoulos et al. (Journal of Virology, 1998) **is maintained.**

Applicant does not specifically argue this ground of rejection. However because Murphy and Skiadopoulos teach the present invention s discussed above and on the record the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AGNIESZKA BOESEN whose telephone number is (571)272-8035. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Agnieszka Boesen/
Examiner, Art Unit 1648
/Bruce Campell/
Supervisory Patent Examiner, Art Unit 1648